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10/686,346

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W. Todd Daniell

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EXAMINER

STRANGE, AARON N

ART UNIT

PAPER NUMBER

2153

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DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/686,346	<b>Applicant(s)</b> DANIELL, W. TODD	
	<b>Examiner</b> AARON STRANGE	<b>Art Unit</b> 2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20080623(2)</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement filed 6/23/2008 contains citations to documents without the required date. See 37 C.F.R. § 1.97(b)(5).

Accordingly, the above noted documents have been lined through and have not been considered by the Examiner. If Applicant wishes for these documents to be considered, they should be re-submitted with proper citations.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-23 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 9-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

5. Claims 9-14 are directed to a "system" comprising a plurality of "means for" performing various functions. The specification of the present application states that these functions are performed by "email application 155" (See *e.g.*, Specification ¶¶26-

28) and discloses that the email application "may be implemented as a computer program" (Specification ¶68). Since claims 19-14 contain no elements limited to hardware, the claim includes at least some software-only embodiments. Since the claim is not limited to statutory embodiments, the claim is non-statutory.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. Claims 1-4, 7, 9-12, 15-18, 21 and 23 are rejected under 35 U.S.C. 102(a) as being anticipated by spamXpress ("anti-spam Rules/Filters for Outlook Express").

8. With regard to claim 1, spamXpress discloses a system, comprising:

a computer device (user's computer running Microsoft Windows)(p. 2, ¶2) of the user configured with a plurality of detection mechanisms ("black list", "white list", "words and phrases" filters)(p. 1, ¶3) that detect undesired email messages that have been received by the user from an email server (messages received from server are filtered before reaching the user's Inbox)(p. 1, ¶3); and

a user interface (Outlook Express) installed on the computer device and configured to visually represent that a particular undesired e-mail message was

detected using a particular detection mechanism, wherein each of the detection mechanisms is represented using a different visual representation (messages matching a filter are highlighted a distinct color and sent to the Spam folder) (p. 1, ¶6; p. 2, ¶1).

9. With regard to claim 2, spamXpress further discloses that the plurality of detection mechanisms includes a mechanism that refuses to detect an email message if the sender of the email message is on a list of senders authorized by the user ("white list" messages are not captured as Spam)(p.1, ¶6).

10. With regard to claim 3, spamXpress further discloses that the plurality of detection mechanisms includes a mechanism that detects an email message if the sender of the email message is on a list of unauthorized senders ("Blacklist" messages are caught by a filter)(p.1, ¶6).

11. With regard to claim 4, spamXpress further discloses that the plurality of detection mechanisms includes a mechanism that detects an email message if the email message contains a textual content string that is on a list of unauthorized textual content strings ("words and phrases" filter captures messages with particular words and phrases used by spammers)(p. 1, ¶6).

12. With regard to claim 7, spamXpress further discloses that the particular undesired email message is, within an email identification list, visually represented

using a particular color that is associated with the particular detection mechanism, wherein the particular color is different from another color that is associated with another detection mechanism (p. 1, ¶6; p. 2, ¶1).

13. Claims 9-12, 15-18, 21 and 23 are rejected under the same rationale as claims 1-4 and 7, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are taught by the above cited art.

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 5, 6, 13, 14, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over spamXpress ("anti-spam Rules/Filters for Outlook Express") in view of Rothwell (US 6,769,016).

16. With regard to claims 5 and 6, while the system disclosed by spamXpress shows substantial features of the claimed invention (discussed above), it fails to disclose a detection mechanism that analyzes the content of previously detected messages and

detects a received message if it is sufficiently similar to the overall content of the previous messages.

Rothwell discloses a similarly system for detecting unwanted electronic mail messages (Abstract). Rothwell teaches a method of detecting unwanted email messages that analyzes the content of previously detected messages (previously detected messages are used to train a neural network)(col. 3, ll. 43-48), and uses this information to determine whether a received message is sufficiently similar to the overall content of the previous messages (once trained, the network is used to accept or deny messages based on a probability score)(col. 3, ll. 48-50; col. 4, ll. 51-58). This would have been an advantageous addition to the system disclosed by spamXpress since it would have allowed spam messages to be detected based on their similarity to other spam even if they are not captured by a filter, reducing the amount of unwanted mail received by the user.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to compare a received message to determine if it is similar to previously received spam messages, and filter messages based on the comparison.

17. Claims 13, 14, 19 and 20 are rejected under the same rationale as claims 5 and 6, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are taught by the above cited art.

18. Claims 8 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over spamXpress (“anti-spam Rules/Filters for Outlook Express”) in view of Paul (US 5,999,932).

19. With regard to claim 8, while the system disclosed by spamXpress shows substantial features of the claimed invention (discussed above), including that the particular undesired email message is, within an email identification list, visually represented in a particular manner (color) that is associated with the particular detection mechanism, wherein the particular manner is different from another manner that is associated with another detection mechanism (p. 1, ¶6; p. 2, ¶1), it fails to specifically disclose that the particular display manner is a particular lettering style.

Paul discloses a similar system for detecting and filtering unwanted electronic mail messages (Abstract). Paul teaches displaying a message by “changing font or appearance of the message subject line to reflect its status” (col. 9, ll. 14-15). This would have been an advantageous addition to the system disclosed by spamXpress since it would have provided additional flexibility in the method of displaying messages detected by various filters.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to display detected messages in a particular lettering style, instead of or in addition to displaying them in a different color, since it would have provided the user with more display options to ensure that the filter which detected a message could be determined from the visual representation of the message.



20. Claims 22 is rejected under the same rationale as claim 8, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are taught by the above cited art.

### ***Conclusion***

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to AARON STRANGE whose telephone number is (571)272-3959. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Glenton B. Burgess/

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Art Unit: 2153

Supervisory Patent Examiner, Art Unit 2153

/A. S./

Examiner, Art Unit 2153